



Attorney Docket No. 0756-2457

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Shunpei YAMAZAKI et al.

Serial No. 10/099,972

Filed: March 19, 2002

For: WIRING AND METHOD OF
MANUFACTURING THE SAME, AND
WIRING BOARD AND METHOD OF
MANUFACTURING THE SAME

) Group Art Unit: 1765

) Examiner: D. Deo

) CERTIFICATE OF MAILING

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Mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450, on May 9, 2005.

Asuke M. Stamps

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed February 7, 2005, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on March 19, 2002, July 15, 2004, and December 20, 2004. A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 7-14, 21-29 and 37-47 are pending in the present application, of which claims 7-10, 21-25 and 37-40 are independent. The Applicants note with appreciation the allowance of claims 7-14, 21, 22, 24, 25 and 37-46 (page 3, Paper No. 020405). It also appears that claims 26-28 as the depend from claims 21, 22, 24 and 25 and claim 29 as it depends from claims 24 and 25 are in condition for allowance. For the reasons

set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects independent claim 23 and dependent claims 26, 29 and 47 as they depend from claim 23 as obvious based on the combination of U.S. Patent No. 6,515,336 to Suzawa et al. and Wolf et al., *Silicon Processing for the VLSI Era*, 1986, Vol. 1, p. 518. (Although the Official Action refers to "Lin" at page 2, it appears that the Official Action intended to refer to Suzawa instead of Lin.) Paragraph 3 of the Official Action rejects claims 27 and 28 as obvious based on the combination of Suzawa, Wolf and U.S. Patent No. 5,912,506 to Colgan et al.

However, Suzawa, as a commonly owned reference under § 102(e), may not be considered for a rejection under § 103. Subject matter developed by another, which qualifies as prior art only under one or more of subsections 35 U.S.C. §§ 102(e), (f) and (g), is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. § 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See MPEP § 2146. Since the disclosure by Suzawa and the claimed invention of the present application were, at the time the invention was made, subject to an obligation of assignment to Semiconductor Energy Laboratory Co., Ltd., Suzawa may not be considered for a rejection under § 103. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

As noted in the attached Information Disclosure Statement, JP 2001-085700 has been submitted, which is a publication of JP 11-264101. U.S. Patent No. 6,515,336 to Suzawa et al. (discussed above, already of record) makes a claim of foreign priority to JP '101. In order to overcome any potential rejections based on JP '700 or JP '101, a verified English translation of priority application JP 2001-091192 filed March 27, 2001, will be filed as soon as it is complete and received from Japan. The Applicants expect to file the verified English translation in early June 2005. Since JP '101 has a filing date of March 30, 2001, which is later than the filing date of JP '192, the Applicants

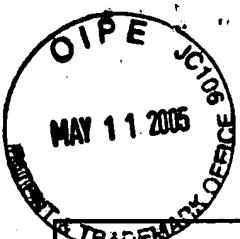
respectfully submit that any potential rejections under §§ 102 and 103 should be overcome.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789



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ENCLOSURES (check all that apply)

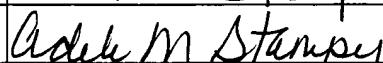
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosures 1. RCE 2. 3. 4. 5. 6.
Remarks <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	May 9, 2005

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